

The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK SIU-YING HUNG

Appeal 2006-3325
Application 09/625,442
Technology Center 3600

Decided: March 23, 2007

Before ANITA PELLMAN GROSS, STUART S. LEVY, and ROBERT E.
NAPPI, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Hung (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 2 through 9, 11 through 13, and 24, which are all of the claims pending in this application.

Appellant's invention relates to a configurable portable electronic communication device for receiving coupon information. Claim 8 is illustrative of the claimed invention, and it reads as follows:

8. A configurable portable electronic communication device comprising:

a receiver configured to receive an electronic wireless transmission containing coupon information;

a processor electronically coupled to the receiver;

an electronic display coupled to the processor;

a memory containing a computer-readable program for generating a scannable coupon on the electronic display of the configurable portable electronic communication device from the coupon information and including instructions for converting the scannable coupon from a first scannable barcode format to a second scannable barcode format.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Gutman	5,221,838	June 22, 1993
Mankovitz	5,523,794	June 04, 1996

Claims 2 through 9, 11 through 13, and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mankovitz.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mankovitz in view of Gutman.

We refer to the Examiner's Answer (mailed April 20, 2006) and to Appellant's Brief (filed January 30, 2006) and Reply Brief (filed June 19, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse the obviousness rejection of claims 2 through 9, 11 through 13, and 24 over Mankovitz and affirm the obviousness rejection of claim 8 over Mankovitz and Gutman. We also enter a new ground of rejection of claims 5 through 7 under 35 U.S.C. § 103 as being unpatentable over Mankovitz in view of Gutman.

OPINION

Appellant contends (Br. 9-10) that Mankovitz's IR detector is not a receiver configured to receive an electronic wireless transmission, as recited in independent claim 8, because IR signals are not considered to be wireless electronic transmissions. Further, Appellant contends (Br. 10-11) that substituting an electronic wireless receiver for the IR detector of Mankovitz would not have been obvious since it "would change the operating principle of the electronic coupon of Mankovitz and require substantial redesign to both the electronic coupon and to the controller." Appellant also contends (Br. 11-12) that Mankovitz fails to suggest instructions for converting the scannable coupon from a first barcode format to a second barcode format. Appellant contends that Mankovitz would not need a second barcode format because the electronic coupons are for local dealers.

The Examiner asserts (Answer 8) that both RF and IR are in the electromagnetic spectrum and are, therefore, electronic transmissions. Therefore, the Examiner concludes that Mankovitz's IR detector satisfies the claimed electronic wireless receiver. Additionally, the Examiner (Answer 4) asserts that Mankovitz teaches that the portable device includes programming to convert a single coupon into several formats such as

alphanumeric and barcode. The Examiner continues that it would have been obvious to have provided the ability to convert the coupon data between different barcode formats "so that different . . . POS scanners requiring various barcode formats can process the coupons, for added flexibility and universality."

Looking at the barcode issue first, we find Mankovitz discloses (Mankovitz, col. 5, ll. 46-47) that the coupon information is to be displayed "in one of *several* formats" (emphasis ours). Mankovitz gives as one example of such formats an alphanumeric display. Mankovitz discloses (Mankovitz, col. 5, ll. 49-53) that a "UPC bar code format is alternatively presented on the display through predetermined key strokes... for use with redemption systems employing a laser scanner or similar system." The use of the word "several" suggests that Mankovitz means to include more than the two enumerated formats. Further, the use of predetermined key strokes to switch to the UPC format suggests that the device is programmed to convert between one format and another when different key strokes are used. However, the disclosure of further formats ends there. Thus, Mankovitz falls short of teaching or disclosing programming to convert one barcode format to another. Since Mankovitz fails to teach or suggest the conversion between two barcode formats of claim 8, we need not reach the issue of whether an IR detector satisfies the claim limitation of a wireless electronic receiver. Thus, we cannot sustain the rejection of claim 8 and its dependents, claims 2 through 7, 9 through 12, and 24, over Mankovitz.

Regarding claim 13, Appellant contends (Br. 23-25) that Mankovitz fails to disclose an electronic wireless receiver. Further, Appellant contends (Br. 25) that Mankovitz fails to disclose the claimed dimension and

interpixel spacing of the display. The Examiner (Answer 3) relies on Mankovitz's IR detector for the receiver and (Answer 5) takes Official Notice that "the visual quality of a barcode is related to the success in registering an error-free scan" to support the obviousness of the claimed dimension and interpixel spacing of the display.

As to the receiver, claim 13 recites "a receiver configured to receive a wireless transmission containing coupon information." Claim 13 does not specify that the wireless transmission must be electronic. An infrared transmission is clearly a wireless transmission. However, regarding the specifics of the display, the Examiner has failed to provide any evidence that would support the Examiner's conclusion that the particular dimension and interpixel spacing of the display would have been obvious. Accordingly, we cannot sustain the obviousness rejection of claim 13 over Mankovitz.

The Examiner (Answer 7) presents an additional rejection of claim 8 over Mankovitz in view of Gutman. The Examiner relies on Gutman for a suggestion to program conversion between different coupon formats. Appellant contends (Br. 29) that Gutman fails to teach converting a displayed barcode from one format to another, and therefore fails to cure the deficiency of Mankovitz discussed *supra*. Appellant does not reiterate the contention that Mankovitz's IR detector does not satisfy the claimed wireless electronic receiver, but we will address that issue for completeness.

First as to the conversion between two barcode formats, as explained *supra*, Mankovitz suggests displaying the coupon information in several formats, one at a time, including an alphanumeric format and a UPC barcode format. A given format is displayed by pressing predetermined keys. Thus, conversion between formats is suggested. However, Mankovitz fails to

disclose that the additional formats are other barcode formats. Gutman discloses (col. 5, ll. 13-24) that the UPC barcode is a subset of the EAN or WPC code, which is used internationally for identifying retail food items and other general merchandise. Gutman also discloses other barcode formats as equivalents for the UPC barcode. Thus, it would have been obvious to the skilled artisan to include as the other of the several formats the EAN or WPC code to use the electronic coupon internationally,¹ or one of the other equivalent standard formats listed by Gutman.

As to the electronic wireless receiver, Gutman discloses (col. 4, ll. 44-51) that a wireless message may be communicated via a communication system (i.e., other than an electronic signal through a physical coupling means) such as through radio frequency (RF) communication, microwave communication (e.g., satellite), optical communication (e.g., infrared (IR)) or ultrasonic communication. Thus, Gutman suggests the equivalence of RF and IR signals for wireless messages. Further, Mankovitz (col. 9, ll. 22-24) recognizes a drawback of IR is that the portable data coupon must be close to the controller. Similarly, Appellant admits (Br. 10) and presents evidence that IR technologies are known to be better suited for short-range communication channels and that electronic wireless transmissions can travel over greater distances and do not have to be aligned with the transmitter. Thus, in view of the known benefits of electronic wireless receivers over IR receivers, the disadvantage of IR recognized by

¹ We disagree with Appellant (Br. 12) that Mankovitz teaches away from the modification because Mankovitz's coupon is intended for local dealers. Mankovitz states (Mankovitz, col. 5, ll. 29-35) that local dealer information is one type of information that may be transmitted, but does not limit the coupon to local dealers only.

Mankovitz, and the equivalence of IR and electronic wireless receivers suggested by Gutman, it would have been obvious to substitute an electronic wireless receiver for the IR receiver of Mankovitz, wherein the necessary modifications for the substitution would have been readily apparent to the skilled artisan. Accordingly, we will sustain the obviousness rejection of claim 8 over Mankovitz in view of Gutman.

Under the provisions of 37 C.F.R. § 41.50(b), we enter the following new ground of rejection against Appellant's claims 5 through 7 under 35 U.S.C. § 103 over Mankovitz in view of Gutman.

Claims 5 through 7 depend from claim 8, for which we have sustained a rejection under 35 U.S.C. § 103 over Mankovitz in view of Gutman, *supra*. Claims 5 and 6 further recite that the memory contains a data file storing coupon information and including subfiles including coupon data fields related to redemption. Mankovitz discloses (Mankovitz, col. 5, ll. 26-41) that coupon information including value of the discount and expiration date of the coupon is sent to the portable electronic coupon and stored in the memory. Accordingly, claims 5 and 6 would have been obvious over Mankovitz in view of Gutman.

Claim 7 recites that the coupon information is encrypted and the computer-readable program contains instructions executable by the program to decrypt the coupon information. Mankovitz discloses (Mankovitz, col. 5, ll. 36-41) that "[t]he data present in the VBI is further encrypted to avoid use by systems other than authorized portable data coupons. The encoded data stripped from the VBI is retransmitted to the portable data coupon where it is stored in temporary memory as previously described." Thus, the coupon data is encrypted before being sent to the memory in the electronic coupon.

Although not explicitly stated, for the information to be used, it must then be decrypted by the microprocessor in the electronic coupon. Therefore, claim 7 would have been obvious over Mankovitz in view of Gutman.

ORDER

The decision of the Examiner rejecting claims 2 through 9, 11 through 13, and 24 under 35 U.S.C. § 103 over Mankovitz is reversed. The decision of the Examiner rejecting claim 8 under 35 U.S.C. § 103 over Mankovitz in view of Gutman is affirmed. Claims 5 through 7 are newly rejected under 35 U.S.C. § 103 over Mankovitz in view of Gutman.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). *See* 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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